

REMARKS

Applicants respectfully request reconsideration the rejections set forth in the Office Action dated September 29, 2004. Claims 50, 64, and 73 have been amended to correct nomenclature informalities identified by Applicants. New claims 87-146 have been added. In the Office Action, claims 46-86 were rejected. More specifically, the status of the application in light of the Office Action was as follows:

(A) Claims 46-86 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6,602,068;

(B) Claims 64-69 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite;

(C) Claims 46-49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,601,073 to Shimek et al. (Shimek '073) in view of U.S. Patent No. 6,006,743 to Shimek et al. (Shimek '743);

(D) Claims 50-54, 70, 71, 73-75, 77, 78, 80, 81, and 83-86 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimek '743 in view of U.S. Patent No. 5,996,575 to Shimek et al. (Shimek '575) or U.S. Patent No. 6,053,165 to Butler et al. (Butler);

(E) Claims 64-69 were indicated as being allowable if rewritten or amended to overcome the rejections under 35 U.S.C. § 112, second paragraph; and

(F) Claims 72, 79, and 82 were objected to as being dependent upon a rejected claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

A. Double Patenting Rejection

In the Office Action, claims 46-86 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6,602,068. Applicants submit along with this response an executed Terminal Disclaimer regarding U.S. Patent No. 6,602,068. Therefore, Applicants request that the doubled patenting rejection of claims 46-86 be withdrawn.

B. Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 64-69 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, because of the phrase "the burner pan." Claim 64, line 7 has been amended to replace "burner pan" with "base." In view of the amendment to claim 64, Applicants request withdrawal of the Section 112 rejection.

C. Rejections Under 35 U.S.C. § 103 – Claims 46-49

Claims 46-49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimek '073 in view of Shimek '743. Claims for an invention are not *prima facie* obvious if the primary references do not suggest all elements of the claimed invention and the prior art does not suggest the modifications that would bring the primary references into conformity with the application's claims. *In re Fritch*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992); *In re Laskowski*, 871 F.2d 115 (Fed. Cir. 1989). Applicants respectfully submit that the cited references can not support a *prima facie* case of obviousness.

Shimek '073 is directed to a flat pan gas burner for a gas log fireplace system. The burner has a U-shaped pan portion 12 with attachment flanges. A top metal plate 14 having fold lines 16 is connected to the pan portion by swaging, spot welding or crimping to the flanges to provide a sealed burner system. Column 3, lines 25-29. The top metal plate can be formed to simulate a coal surface and coated with a layer ceramic material. Shimek '073 states: "It will be appreciated that the novel flat pan gas burner system essentially comprises two parts which are formed from sheet metal and easily assembled on an automatic production line for minimum costs and maximum

quality and flexibility of providing a pattern of ports therein." Column 3, lines 29-34. Accordingly, the flat pan gas burner system taught by Shimek '073 requires the U-shaped metal pan over which the top metal plate can be secured via an automated production line process to form a gas manifold within the flat pan gas burner.

Shimek '073 does not disclose, teach or suggest a burner assembly as claimed in claims 46-49 having a burner body with first and second recessed gas distribution chamber portions formed therein. Shimek '073 teaches the flat metal top plate that attaches to the U-shaped pan to form a gas manifold. Shimek '073 also does not disclose, teach or suggest a burner body as claimed having a contoured surface simulates an ember bed, and a simulated log supported adjacent to the simulated ember bed. The reference is silent as to such a configuration.

Shimek '743 cannot and does not correct the deficiencies of Shimek '073. Shimek '743 is directed to an indoor-outdoor portable gas burner having a ceramic fiber top. Figure 9, to which the Examiner cited, is described in Shimek '743 of column 4, lines 47-64, as showing a ceramic fiber top 12 having pattern of burner jets and supporting structure which surrounds an H-shaped manifold area 13 formed in the fiber top. The ceramic fiber top is mounted to a base unit 11. A bead of adhesive is applied around the manifold area close to the outside perimeter of the top unit before it is attached to either the base unit.

Examiner asserts in the Office Action that Figure 9 of Shimek '743 teaches the use of a burner body comprising first and second recessed gas distribution chamber portions and that Shimek '073 could be modified to include the ceramic fiber top of Shimek '743 to provide the claimed invention. Applicants respectfully disagree. Shimek '073 teaches forming a metal burner with a U-shaped pan and a top metal plate using an automated production line. Shimek '073 teaches away from using a molded ceramic fiber top that is mounted to a base unit with an adhesive as disclosed in Shimek '743. In fact, Shimek '743 distinguishes itself from the Shimek '073 in the background section at Column one, lines 12-40, indicating that the references are substantially different and the construction is not interchangeable.

Neither of the two cited references provides a suggestion or motivation to replace the top metal plate of Shimek '073 with a molded ceramic fiber top having a recessed H-shaped manifold portion as only briefly described in Shimek '743. Further, each reference teaches a different way to form a manifold, one with the U-shaped pan and the other by forming it into a ceramic fiber top. There is no motivation in either reference for combining the structures as suggested by the Examiner. Such a modification to combine the structures would destroy the intended function of the burner assemblies defined by the references. Any modification of the teaching of Shimek '073 with the teachings of Shimek '743 to provide the claimed invention in the present application would only be apparent to one skilled in the art after fully understanding the present invention, applying impermissible hindsight and using the present application as a template to construct the claimed burner assembly. Therefore, the combination of references does not establish a *prima facie* case of obviousness to support the rejection. Applicants respectfully request the rejection of claims 46-49 be withdrawn and the claims allowed.

D. Rejection Under 35 U.S.C. § 103 – Claims 50-54, 70, 71, 73-75, 77, 78, 80, 81, and 83-86

Claims 50-54, 70, 71, 73-75, 77, 78, 80, 81, and 83-86 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimek '743 in view of either Shimek '575 or Butler. Shimek '575 is directed toward a prefabricated fireplace having an open-ended fiber insulation firebox and a combustion chamber formed or a molded in one piece from a slurry of refractory ceramic fibers. Column 1, lines 12-16. Shimek '575 describes the fireplace as having "a hollow flat pan burner 57 which preferably has a ceramic top that is formed as a bed of coals or burned wood and is shown in detail and described in our U.S. Patent No. 5,601,073 which issued Feb. 11, 1997." Column 4, lines 35-39. Other than this brief reference to Shimek '073, Shimek '575 does not discuss further details of the burner system's construction. Shimek '575's limited disclosure of a burner does not correct the deficiencies of Shimek '743. And, as discussed above, Shimek '743 can not be properly combined with Shimek '073, upon which Shimek '575 relies for details about the burner system's construction

Butler also does not correct the deficiencies of Shimek '743. Butler teaches a gas fireplace that may be turned on or off all while trying to maintain a realistic simulation of glowing embers and burning logs by providing a light source below a translucent glass panel to generate flickering light visible through the panel. Column 1, lines 6-11. Accordingly, Butler teaches creating the illusion of light produced by burning logs, but without the heat. Column 1, lines 53-54. The burner assembly uses the translucent glass panel with a glass frit molded and bonded on to the base panel to form a simulated coal bed. The translucent glass panel includes a colored pattern that is projected as light onto a log set supported above the translucent glass panel.

Shimek '743 does not teach, disclose, or suggest a burner assembly having, *inter alia*, a base and a nonmetallic burner body as claimed having a contoured surface that forms a simulated log support surface that supports a simulated log adjacent to simulated coal members. Shimek '575 does not teaches the details of a burner assembly except by referencing Shimek '073, which can not be combined with Shimek '743 to form the basis for an obviousness rejection, as discussed above. Butler does not disclose, teach or suggest such a burner assembly with a nonmetallic burner body constructed of a material that glows at selected color variations as claimed and wherein the contoured surface of a burner body forms a simulated log support surface that supports a simulated log adjacent to simulated coal members. Butler teaches the use of a light source below the translucent glass panel to generate an illusion of glowing embers without generating heat. Therefore, Butler teaches away from providing a burner assembly with a body constructed of a material that glows at selected color variations when fuel gas is ignited adjacent to the body.

Any modification of Shimek '743 to provide the translucent glass panel of Butler would destroy the intended function of the indoor-outdoor burner of Shimek '743. Further, any modification to the indoor-outdoor burner of Shimek '743 in view of the limited teachings of Shimek '575 or Butler to provide the claimed burner assembly of the present application would only be apparent to one of ordinary skill in the art after

fully understanding the present invention and applying impermissible hindsight analysis. Therefore, the claims are patentable over the applied references.

Regarding the rejection of claims 70 and 71, the applied references taken alone or in combination do not teach or suggest a burner assembly as claimed with a base, a burner body spaced apart from the base by a separator and constructed of a material that glows at selected color variations when fuel gas is ignited adjacent to its contoured surface. Shimek '743 teaches the use of a highly countered ceramic fiber top that does not need a separator. There is no suggestion or motivation to modify the teachings of Shimek '743 in view of Shimek '575 or the translucent burner of Butler, as discussed above, to provide the burner assembly as claimed. Any such modification would only be apparent to one skilled in the art after understanding the present invention and applying impermissible hindsight analysis. Therefore, claims 70-71 are patentable over the applied references and are in condition for allowance.

Regarding claim 73 and its dependent claims 74, 75, 77, 78 and 80, none of the applied references alone or in combination disclose, teach or suggest a burner assembly as claimed having a burner body with a lower portion having a first flat undersurface portion spaced apart from a base and a second undersurface portion spaced apart from the base and recessed from the first undersurface portion. Shimek '743 only briefly describes at Column 4, line 47-Column 5, line 3 an indoor/outdoor burner assembly having a ceramic fiber top with an H-shaped manifold formed therein. Shimek '743 provides no discussion, teaching or suggestion of a burner assembly wherein a lower portion of a burner body having a first flat undersurface portion spaced apart from a base and a second undersurface spaced apart from the base and recessed from the first undersurface as claimed. Neither Shimek '575 nor Butler corrects the deficiency of Shimek '743, to the extent that they could be combined with the primary reference. The only teachings of such a burner assembly configuration is provided in the present application and any modification of the teachings of the cited references would only be apparent to one skilled in the art after understanding the present invention and applying impermissible hindsight analysis. Therefore, claims 73-

75, 77, 78, and 80 are patentable over the applied references and are in condition for allowance.

Regarding claim 81 and its dependent claims 83-86, the claims are directed to a burner assembly having, *inter alia*, a base and a burner body with a contoured surface, wherein a portion of the contoured surface forms a simulated log support portion to support one or more simulated logs adjacent to simulated coal members. As discussed above, the cited references taken alone or in combination to the extent possible, teach a burner assembly with such a construction as claimed. The only teaching of such a configuration is provided by the present application. There is no suggestion or motivation to modify the burners of the cited references to provide the claimed configuration. Therefore, claims 81 and 83-86 are patentable over the cited references and are in condition for allowance.

E. New Claims

New claims 87-146 have been added to further clarify and claimed the burner assembly in accordance with the present invention. No new matter has been added. Applicants respectfully submitted that the claims are patentable over the cited references and are in condition for allowance.

F. Conclusion

In view of the foregoing, the claims pending in the application comply with the requirements of 35 U.S.C. § 112 and patentably define over the applied art. A Notice of Allowance is, therefore, respectfully requested. If the Examiner has any questions or

believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-3259.

Respectfully submitted,

Perkins Coie LLP

A handwritten signature in black ink, appearing to read 'R. Woolston', is written over a horizontal line.

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